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EXAMINER

ALVAREZ, RAQUEL

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/017,111
Filing Date: December 14, 2001
Appellant(s): MATZ ET AL.

MAILED

JUL 24 2006

Technology Center 2600

Scott P. Zimmerman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/28/2006 appealing from the Office action
mailed 12/13/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4, 6-15 and 18-38 are rejected under 35 U.S.C. 103(a) as being unpatentable by Knudson et al. (WO 99/45702 hereinafter Knudson).

With respect to claims 1-3, 7, 9, 12, 15, 19, 21, 30-32, 34 Knudson teaches a method for marketing (Abstract). Defining a match between a user classification and an incentive (i.e. matching user's interest to advertisements)(page 14, lines 14-31); Receiving from a set-top box user data associated with a user's cable television viewing selections (see Figure 1, item 48); receiving the user's purchase records (i.e. the system receives data related to user's purchases of pay programs)(page 9, lines 5-9); classifying the user in a user classification when the user's cable television viewing selections relate to the user's purchase records (i.e. based on the user's programs viewed and the programs purchased by the user, the system targets advertisements to the user)(page 10, lines 5-21; page 11, lines 22-32; page 14, lines 14-31 and page 19, lines 20 to page 20, lines 1-8 and Figure 16).

With respect to purchase record being made with a credit card describing purchases from retail stores and classifying the user according to purchases from the retail stores. Knudson teaches receiving data related to programs ordered/purchased by the users and classifying the users according to their purchases (page 9, lines 5-9 and page 10, lines 8-11). Knudson is silent as to if the purchases records are for people that have purchased with credit cards and that the purchases are for purchases from retail stores. Official notice is taken that is old and well known that credit cards are old

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an well known method used to make purchases in order to provide a convenient method to buy merchandises on credit and to also monitor purchases made at retail establishments in order to keep track of what the customers are purchasing at the different establishments. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the purchase records to have been credit card purchases and to monitor purchases from retail stores because such a modification would allow to better target the customers based on if they have credit and to keep track of the purchases made at retail stores in order to better target the customer based on how they pay for the purchases and the retail establishments that they purchase from.

With respect to claim 4, Knudson further teaches that the user's television viewing selection comprises how much of an advertisement the user views (page 27, lines 29 to page 32, lines 1-10).

With respect to claims 6, 8, 18 and 20, Knudson further teaches further classifying the user based on the user's television viewing selections if the user views advertisements for a product and purchases the product (see Figure 24).

Claims 10, 22 further recites that the user data comprises survey data. Official notice is taken that is old and well known in marketing to ask consumers questions about their likes and dislikes and to record the answers to those questions in order to

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better target the users based on their answers. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included survey data in order to obtain the above mentioned advantage.

With respect to claims 11 and 23, Knudson further teaches that the user data comprises a price paid for the product and the time the product was purchased (Figure 8).

Claims 13 and 27 further recites that the incentive comprises a coupon. Knudson teaches providing advertisements. Knudson doesn't necessarily teach that the advertisements are in the form of a coupon. Official notice is taken that is old and well known in marketing to provide coupons to the customers because such a modification would further motivate the customers to make a purchase by providing a discount. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the incentive to be in the form of a coupon in order to obtain the above mentioned advantage.

With respect to claims 14 and 26, Knudson further teaches that the incentive comprises a banner (See Figure 8, item 124).

With respect to claims 24-25, 28, 29, Knudson further teaches that the incentive comprises an image embedded into cable television media content, video program (page 14, lines 3-7).

Claim 33 further recites transmitting the incentive to the user by mail. Official notice is taking that it is old and well known to provide incentives to the user by mail. For example, advertisements are old and well known to be sent to the users by mail in order to cast a large group of people. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included transmitting the incentive to the user by mail in order to obtain the above mentioned advantage.

Claim 35 further recites receiving records related to a shopping card in which the user is given a discount in exchange for using the shopping card. Official notice is taken that it is old and well known in marketing to give incentives or discount to the user to motive them to use a preferred method of payment or the like. For example, Macy's will give a discount to the customers if they make purchases with their Macy's card. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included receiving records related to a shopping card in which the user is given a discount in exchange for using the shopping card in order to obtain the above mentioned advantage.

Claims 36-37 further recite receiving a separate identification codes identifying each user of a common user terminal. Official notice is taken that it old and well known to use codes or passwords to identify each user of a common terminal. For example, Microsoft XP interface allows each user of a common terminal to enter a password in order to identify each of the user of the system. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included receiving a separate identification codes identifying each user of a common user terminal in order to distinguish one user from the other user of the same terminal.

Claim 38 further recites that the incentive comprises a redeemable coupon. Knudson teaches providing advertisements. Knudson doesn't necessarily teach that the advertisements are in the form of a redeemable electronic coupon. Official notice is taken that is old and well known in computer related arts to provide redeemable electronic coupons to the customers because such a modification would further motivate the customers to make a purchase by providing a redeemable electronic coupon. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the incentive to be in the form of a redeemable electronic coupon in order to obtain the above mentioned advantage.

(10) Response to Argument

Appellant argues that Knudson doesn't teach receiving the user's credit card purchase records describing purchases from retail stores and classifying the users based on the user's television viewing selections and purchases from retail stores. The

Examiner respectfully disagree with Applicant. Knudson teaches classifying users according to user's viewing selections and purchases of pay-per view programs on("e.g. , **pay program account information or information regarding programs that have been purchased and viewed**) page 10, lines 8-11 since the customer is making the purchased electronically then using a credit card is inherent or at least obvious in the system of Knudson to pay for the pay programs. The only substantial difference between Knudson and Applicant's invention is that in applicant's invention the purchases are made via a retail store. The Examiner has taken official notice that monitoring purchases made at retail establishments is old and well known in order to keep track of what the customers are purchasing at the different establishments.

Appellant argues that Knudson doesn't teach classifying the user in a user classification when the user's television viewing selections relate to the user's purchases. The Examiner disagrees with Appellant because Knudson teaches that based on the television programs viewed by the users and the pay per view programs purchased by the user, the system determines the user's interest and targets advertisements based on the users viewing habits and the pay per view purchases (page 14, lines 14-31).

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

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the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skilled in the art given the Knudson reference which teaches monitoring the user's viewed programs and the pay per viewed programs in order to target ads based on the users viewing selections and the programs bought would have replaced the pay per view programs bought with purchases bought at a retail establishments in order to keep track of the purchases made directly at the local or retail establishments.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Raquel Alvarez

Conferees:

Eric Stamber

Yehdega Retta